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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,694	11/06/2000	Joseph M. Cannon	Cannon 110-100	7842

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WASHINGTON, DC 20037-1526

EXAMINER
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SOBUTKA, PHILIP

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 03/11/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/705,694

Applicant(s)

CANNON ET AL.

Examiner

Philip J. Sobutka

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-51, 53, 54 and 57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51, 53, 54 and 57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Claim Rejections - 35 USC § 103

1. Claims 1,2,6,9-11,14-16,22,25,26,35,36,40,43,44, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanpei et al (US 5,732,349) in view of Pfeffer et al (US 6,529,728).

Consider claims 1,2,16,36. Sanpei teaches a system comprising: a plurality of base stations at specific locations (Sanpei see especially fig 1) which transmit information specific to the locations (Sanpei see especially col 4, lines 10-15); a transceiver in a portable device (Sanpei see especially fig 5) controlled by a processor (Sanpei see especially fig 3, item 21); wherein when the portable device comes into range of one of the plurality of base stations the device receives the radio signal from one of the plurality of base stations, and based on the information updates information stored in the memory of the device (Sanpei see especially col 5, lines 50-60). Sanpei lacks a teaching of the portable device automatically establishing communication and updating the information. Pfeffer teaches a system wherein portables automatically establish communication and update location information (Pfeffer see especially fig 4, items 402, 408). Pfeffer teaches that this allows the information to be updated without user intervention using minimum system overhead (Pfeffer col 6, lines 18-26). It would have been obvious to one of ordinary skill in the art to modify Sanpei to provide automatic communication and updates as taught by Pfeffer in order to allow the information in the portable to be updated without user intervention.

As to claim 35, the system of Sanpei would perform the claimed steps.

As to claim 15, note that Sanpei's device includes a processor, memory and receiver (Sanpei see especially fig 3).

As to claim 6,22,40, note that Sanpei teaches the signal including time zone information (Sanpei see especially col 7, lines 29-44).

As to claim 9, note that the information includes a telephone country code (Sanpei see especially col 5, lines 50-60).

As to claims 10-11,25-26,43-44, note that Sanpei teaches that the transceiver is set to predefined frequencies based on the country code (Sanpei see especially col 7, lines 25-30).

Consider claim 14. Sanpei in view of Pfeffer teaches everything claimed except for the device being Bluetooth™ compliant. Official Notice is taken that Bluetooth™ is notoriously well known in the art. It would have been obvious to one of ordinary skill in the art to modify Sanpei in view of Pfeffer to include compliance with Bluetooth™ in order to ensure compatibility with a standard that is growing in popularity.

2. Claims 5, 21,39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanpei in view of Pfeffer and in view of Konno (US 6,282,431).

Sanpei in view of Pfeffer teaches everything claimed including the update signal indicating time zone (Sanpei see especially col 7, lines 29-44). Sanpei in view of Pfeffer lacks a teaching of the device including a clock Konno teaches a portable device that updates for the time zone based on location including a clock (Konno see especially fig 1, item 5, col 3, line 52 – col 4, line 11). It would have been obvious to one of ordinary

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skill in the art to modify Sanpei in view of Pfeffer to include a clock in order to provide a local time source.

3. Claims 3,7,17-19,23,37,41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanpei in view of Pfeffer and in view of Tomiyori (US 5,305,372).

Consider claims 3,7,19,23,37,41. Sanpei in view of Pfeffer teaches everything claimed except for the information that is updated based on location including speed dial numbering. Tomiyori teaches a mobile that updates speed dialing based on the mobile's location (Tomiyori see especially col 3, lines 42- col 4, line 47). Note that the updating includes the location area code (Tomiyori see especially col 3, lines 41-57). Tomiyori teaches that this allows the speed dial numbers to be used with the proper international access codes automatically appended. It would have been obvious to one of ordinary skill in the art to modify Sanpei in view of Pfeffer as taught by Tomiyori to update the speed dialing based on location in order to ensure that the speed dialed number has the proper international access codes automatically appended.

Consider claims 17,18. Sanpei in view of Pfeffer lacks a teaching of presenting an indication of the country update to the user, the device only updating information upon user input. Tomiyori also teaches presenting the country update to the user, and only updating upon user input (Tomiyori, col 3, lines 42-60). It would have been obvious to one of ordinary skill in the art to modify Sanpei in view of Pfeffer to present the update to the user for approve before commencing in case the user did not wish to alter the unit for use in the new location as taught by Tomiyori.

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4. Claims 4,20,38, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanpei in view of Pfeffer and in view of Moon et al (US 6,085,098).

Sanpei in view of Pfeffer teaches everything claimed except for the information that is updated based on location including a calendar. Moon et al teaches a portable device that updates its calendar on the basis of location (Moon col 7, lines 30-35). It would have been obvious to one of ordinary skill in the art to modify Sanpei in view of Pfeffer to also update the calendar in order to ensure that the user was aware of the local holidays and could plan accordingly.

5. Claims 8,24,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanpei in view of Pfeffer and in view of Nakamura (US 6,201,963).

Sanpei in view of Pfeffer teaches everything claimed except for the information that is updated based on location including a date. Nakamura teaches a portable device that updates its date on the basis of location (Nakamura col 4, lines 30-50). It would have been obvious to one of ordinary skill in the art to modify Sanpei in view of Pfeffer to also update the date in order to ensure that the user always had the current date.

6. Claims 12,13,27,28,30,31,34,46,49-50,53,54,57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanpei in view of Pfeffer and in view of Siddiqui et al (US 6,292,666).

Consider claims 12,27, Sanpei in view of Pfeffer teach everything claimed except for the device including a global positioning satellite (GPS) receiver, wherein the country is determined using the position determined by the GPS receiver. Siddiqui teaches a

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mobile equipped with a GPS receiver that determines the country based on the position determined by the GPS receiver (Siddiqui see especially fig 6). It would have been obvious to one of ordinary skill in the art to equip the device of Sanpei in view of Pfeffer with the GPS receiver used to determine the country code in order to increase the accuracy of the position determination using the highly accurate GPS system.

As to claim 13,28,54 note that Sanpei teaches a look up table (Sanpei see especially col 5, lines 35-60).

As to claim 30,31,46,57 the device of Sanpei in view of Pfeffer and in view of Siddiqui as modified above would perform the claimed steps.

As to claims 40,50, note that the information updated by Sanpei includes time zones (Sanpei see especially col 7, lines 29-44).

As to claim 53, note that the information includes a telephone country code (Sanpei see especially col 5, lines 50-60).

7. Claims 34,49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanpei in view of Pfeffer and in view of Siddiqui and in view of Konno (US 6,282,431).

Sanpei in view of Pfeffer and in view of Siddiqui teaches everything claimed including the update signal indicating time zone (Sanpei see especially col 7, lines 29-44). Sanpei lacks a teaching of the device including a clock. Konno teaches a portable device that updates for the time zone based on location including a clock (Konno see especially fig 1, item 5, col 3, line 52 – col 4, line 11). It would have been obvious to one of ordinary skill in the art to modify Sanpei in view of Pfeffer and in view of Siddiqui to include a clock in order to provide a local time source.

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8. Claims 32,47,51, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanpei in view of Pfeffer and in view of Siddiqui as applied above and in view of Tomiyori (US 5,305,372).

Sanpei in view of Pfeffer and in view of Siddiqui teaches everything claimed except for the information that is updated based on location including speed dial numbering. Tomiyori teaches a mobile that updates speed dialing based on the mobile's location (Tomiyori see especially col 3, lines 42- col 4, line 47). Note that the updating includes the location area code (Tomiyori see especially col 3, lines 41-57). Tomiyori teaches that this allows the speed dial numbers to be used with the proper international access codes automatically appended. It would have been obvious to one of ordinary skill in the art to modify Sanpei in view of Pfeffer and in view of Siddiqui as taught by Tomiyori to update the speed dialing based on location in order to ensure that the speed dialed number has the proper international access codes automatically appended.

9. Claims 33,48, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanpei in view of Pfeffer and in view of Siddiqui and in view of Moon et al (US 6,085,098).

Sanpei in view of Pfeffer and in view of Siddiqui teaches everything claimed except for the information that is updated based on location including a calendar. Moon et al teaches a portable device that updates its calendar on the basis of location (Moon col 7, lines 30-35). It would have been obvious to one of ordinary skill in the art to modify Sanpei in view of Pfeffer and in view of Siddiqui to also update the calendar in



order to ensure that the user was aware of the local holidays and could plan accordingly.

### **Response to Arguments**

10. Applicant's arguments filed 12-15-2003 have been fully considered but they are not persuasive.

Applicant argues that Sanpei only transfers information relating to an area code; therefore the claimed location dependent information distinguishes over Sanpei. In the first place clearly an area code is location dependent information, therefore the claim does not distinguish over this teaching. Secondly the location dependent information that applicant's invention is concerned with is related ensuring that the proper area code is appended to pre-stored speed dialing number, see for example the summary of the invention on page 3, lines 10-16 of the instant specification.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation for each of the combinations has been provided in each of the rejections.

### ***Conclusion***

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J. Sobutka whose telephone number is 703-305-4825. The examiner can normally be reached on Monday-Friday 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Philip Sobutka

Pjs  
March 3, 2004

  
**NAY MAUNG**  
**SUPERVISORY PATENT EXAMINER**

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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